

REMARKS

Claims 1-54 are pending in the application. The Examiner objects to the abstract of the disclosure and the disclosure for informalities. Claims 1, 5, 11, 15, 21, and 25 are objected to for informalities. Applicants respectfully request the Examiner to withdraw the objections to the specification and accept the claim amendments which address the Examiner's objections to the claims.

Claims 1-30 are rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully request the Examiner to accept the claim amendments which address the rejections to the claims under 35 U.S.C. § 112, second paragraph.

Claims 1-54 are rejected under 35 U.S.C. §103(a). Applicants respectfully traverse these rejections for at least the reasons below and respectfully request the Examiner to reconsider and withdraw these rejections.

I. OBJECTIONSA. Specification

The abstract of the disclosure stands objected to according to the Examiner because "the opening left parenthesis on lines 1 and 2 each do not have a corresponding closing right parenthesis." *See* Office Action 04/05/2005, p.2. Applicants respectfully request the Examiner to withdraw this objection because no parentheses are found in lines 1 and 2 of the abstract submitted in the application (page 34) and in as much as no other errors in matching left and right parentheses were discovered in the abstract of the disclosure.

The disclosure stands objected to according to the Examiner for the following informalities:

- page 14 line 8, "is YES" should be added to after the word "compare"
- page 15 line 15, "is YES" should be added to after the word "compare"

Applicants respectfully request the Examiner to withdraw this objection because no instance of the word "compare" is found at the given locations in the disclosure and in as much as no other

errors in the use of "is YES" or "is NO" to describe compare operations in the application, as depicted in the drawings, were discovered in the disclosure.

### B. Claim Objections

Claims 1, 5, 11, 15, 21, and 25 stand objected to for informalities involving minor typographical errors. The grounds for these objections are acknowledged. The Examiner is respectfully requested to accept the enclosed claim amendments which correct each and every one of the stated informalities (missing space, missing word "from").

## II. REJECTIONS

### A. Claim Rejections under 35 U.S.C. § 112

Claims 1 - 30 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, claims 1, 11, 21, and 24 stand rejected by the Examiner for insufficient antecedent basis for the limitations contained in the respective claims. The remaining claims 2, 3, 4, 5, 6, 7, 8, 9, 10, 12, 13, 14, 15, 16, 17, 18, 19, 20, 22, 23, 25, 26, 27, 28, 29, and 30 stand rejected by virtue of dependency on the foregoing claims. The grounds for these rejections under 35 U.S.C. §112 are acknowledged as indefinite claim language. The Examiner is respectfully requested to accept the enclosed claim amendments which correct the indefinite claim language in claims 1, 11, 21, and 24.

### B. Claim Rejections under 35 U.S.C. § 103(a)

Claims 1, 3, 7-9, 21, 23, 27-29, 31, 34-36, and 39-41 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Stevelim* (as referred to in the Examiner's Office Action) in view of *Lovelace et al.* (U.S. Patent 6,263,431). Applicants respectfully traverse these rejections for at least the reasons below and respectfully request the Examiner to reconsider and withdraw these rejections.

A *prima facie* case of obviousness under 35 U.S.C. §103(a) requires the Examiner to provide some reason, suggestion or motivation to have combined or modified the references. In order to establish a *prima facie* case of obviousness, it is necessary for the Examiner to present objective evidence, preferably in the form of some teaching, suggestion, incentive or inference in

the applied prior art. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (BPAI 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 U.S.P.Q. 657 (CA FC 1985). The legal conclusion of obviousness must be supported by facts. *Graham v. John Deere & Co.*, 383 U.S. 1 (1966). Where the legal conclusion of obviousness is not supported by facts, it cannot stand. *Id.*

Two basic tests may be applied to determine if obviousness is correctly deduced from a combination of the prior art:

a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and

b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable implication.

*In re Sernaker*, 702 F.2d 989, 217 USPQ 1, 5 (CA FC 1983) emphasis added. The question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *In re Fulton*, 73 USPQ2d 1141, 1145 (CA FC 2004). *In re Beattie*, 974 F.2d 1311, 24 USPQ2d 1040, 1042 (CA FC 1992). *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (CA FC 1984) emphasis added. Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings. *In re Sernaker*, 702 F.2d 989, 217 USPQ 1, 6 (CA FC 1983).

B.1 Regarding Claims 1 and 21, the Examiner has not provided appropriate motivation to combine *Stevelim* with *Lovelace*.

The Examiner admits that *Stevelim* does not teach several limitations of claim 1, including hashing a boot record into a digest, using cryptographic engines to generate signatures, storing signatures in non-volatile memory, and assigning specific entries in non-volatile memory to bootable programs. See Office Action 04/05/2005, p. 4. The Examiner declares as obvious to one of ordinary skill in the art "to modify boot managers (such as lilo [sic]) as disclosed by *Stevelim* according to the limitations recited in claims 1 and 21 in light of *Lovelace*'s teachings." See Office Action 04/05/2005, p. 6. The Examiner's cited motivation for one of ordinary skill in the art to combine the references is "to verify the integrity of the boot components prior to the use of the boot components" in order to ensure "that a virus hasn't corrupted the boot components" See Office Action 04/05/2005, p. 6. Applicants respectfully traverse. In addition to the Examiner's admissions above, *Stevelim* does not teach methods for securing boot components for protecting boot environments from unauthorized or undesired access, from infection by a virus, or from damage effected by any other kind of malignant software code. Therefore, *Stevelim* does not provide any motivation to combine his teachings with *Lovelace*, and does not suggest the desirability of any combination that teaches the advantage of the present invention, claims 1 and 21. *Lovelace* does not teach having a first and second entry corresponding to first and second versions of a boot program, or designating which version of a bootable program is to be booted upon a power up of the computer system. Therefore, *Lovelace* does not provide any motivation to combine his teachings with *Stevelim*, and does not suggest the desirability of any combination that teaches the advantage of the present invention, claims 1 and 21.

Using the test (a) as cited above (*In re Sernaker*), the combination of *Stevelim* and *Lovelace* does not suggest, expressly or by reasonable implication, an improvement along the lines of the invention, as embodied in claims 1 and 21. Applying test (b) as cited above (*In re Sernaker*), the invention, as embodied in claims 1 and 21, clearly achieves more than *Stevelim* in view of *Lovelace* suggests, expressly or by implication. Applicants respectfully assert that there is nothing in the prior art which suggests the desirability, ergo the obviousness, of combining *Stevelim* with *Lovelace*. The Examiner has provided no objective basis for the rationale to combine *Stevelim* and *Lovelace* other than the Examiner's subjective opinion, which is not

objective evidence. The factual question of motivation to combine references is material to patentability. *In re Lee*, 61 USPQ2d 1430, 1434 (CA FC 2002). The question is whether the prior art, considering its scope and content and the level of ordinary skill, must itself suggest the combination of separate elements into the claimed invention in suit, not just whether it illustrates separate elements. *The Laitram Corporation et al. v. Cambridge Wire Cloth Company*, 226 USPQ 289, 293 (DC Md 1985). Since the Examiner is unable to point to any specific teaching or suggestion in the prior art of the advantage to combine *Stevelim* and *Lovelace*, other than illustrating certain separate elements that appear in the prior art, Applicants respectfully conclude that the Examiner has rejected claims 1 and 21 based on hindsight, using knowledge of the claimed invention to construct a case for obviousness in rejecting the invention. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, to use the inventor's teaching against him. *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (CA FC 1983). In summary, Applicants respectfully assert that the Examiner withdraw the rejection of claims 1 and 21 and allow these claims for issue.

#### B.2 Dependent claims 3 and 23

Claims 3 and 23 depend from claims 1 and 21 with the additional limitation of a boot program that is an operating system. Claims 3 and 23 are therefore allowable for at least the reasons cited in section B.1 of this paper. Applicants respectfully assert that the rejection of claims 3 and 23 be withdrawn.

#### B.3 *Stevelim* and *Lovelace*, taken singly or in combination, do not teach or suggest the limitations in claims 7 and 27; no appropriate motivation to combine the references

The Examiner cites *Stevelim* as disclosing "known boot managers that can handle more than just one OS," See Office Action 04/05/2005, p. 7, and *Lovelace* as disclosing "a way to monitor boot components to make sure they are not corrupted." See Office Action 04/05/2005, p. 7. The Examiner states that "one of ordinary skill would be motivated on the indication that an entry/OS boot component is corrupted to monitor other OS's boot components" to determine if another OS "could be booted to from which repairs could be effected." Applicants respectfully traverse the Examiner's reasoning and respectfully assert that neither *Stevelim* nor *Lovelace*, taken singly or in combination, teach or suggest monitoring an entry in non-volatile memory for an indication of validity. There is no objective evidence in *Stevelim* for monitoring corrupted boot components. *Stevelim* does not address verification of integrity of

boot components and does not discuss protection of bootable partitions from infection by a virus, or any other kind of malignant software code. *Lovelace* does not address monitoring multiple entries in non-volatile memory for an indication of validity. Neither *Stevelim* nor *Lovelace* teach or suggest that an alternate OS could be booted on an indication of corruption or invalidity of the selected primary OS to be booted. Neither *Stevelim* nor *Lovelace* teach or suggest methods for booting into an OS for effecting "repairs on damages that were possible done by viruses," as the Examiner states as additional motivation for monitoring a third entry for validity. There is no language in the references that teaches that a third entry would exist, and that this third entry in non-volatile memory is monitored to determine if it is valid, i.e. there is a value stored in the entry, and that the value corresponds to a loaded boot program. Therefore the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 7 and 27, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (CA FC 1998).

Further, Applicants respectfully assert that there is nothing in the prior art which suggests the desirability, ergo the obviousness, of combining *Stevelim* with *Lovelace*. The Examiner has provided no objective basis for the rationale to combine *Stevelim* and *Lovelace* other than the Examiner's subjective opinion, which is not objective evidence. The factual question of motivation to combine references is material to patentability. *In re Lee*, 61 USPQ2d 1430, 1434 (CA FC 2002). The question is whether the prior art, considering its scope and content and the level of ordinary skill, must itself suggest the combination of separate elements into the claimed invention in suit, not just whether it illustrates separate elements. *The Laitram Corporation et al. v. Cambridge Wire Cloth Company*, 226 USPQ 289, 293 (DC Md 1985). Since the Examiner is unable to point to any specific teaching or suggestion in the prior art of the advantage to combine *Stevelim* and *Lovelace*, other than illustrating certain separate elements that appear in the prior art, Applicants respectfully conclude that the Examiner has rejected claims 7 and 27 based on hindsight, using knowledge of the claimed invention to construct a case for obviousness in rejecting the invention. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, to use the inventor's teaching against him. *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (CA FC 1983). In summary, Applicants respectfully assert that the Examiner withdraw the rejection of claims 7 and 27 and allow these claims for issue.

B.4 *Stevelim* and *Lovelace*, taken singly or in combination, do not teach or suggest the limitations in claims 8 and 28; no appropriate motivation to combine the references

The Examiner admits that *Stevelim* and *Lovelace* do not teach the limitations of claims 8 and 28. The Examiner argues obviousness based on allowing "a way to replace one of the previous two OS entries with the third entry for boot managers than only handles [sic] two OS's." See Office Action 04/05/2005, p.8. The Examiner also states that the "choice of replacing the first entry as opposed to the second is arbitrary." See Office Action 04/05/2005, p.8. Applicants respectfully traverse the rejection of claims 8 and 28. Neither *Stevelim* nor *Lovelace* teach a mechanism for advancing or incrementing the currently registered boot program from the second entry to the first entry in response to a valid indication from the result of the monitoring step in claims 7 and 27, respectively. Since the step in claims 8 and 28 is specified in dependency to the step in claims 7 and 27 respectively, the step is not arbitrary. Therefore the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 8 and 28, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (CA FC 1998).

Further, Applicants respectfully assert that there is nothing in the prior art which suggests the desirability, ergo the obviousness, of combining *Stevelim* with *Lovelace*. The Examiner has provided no objective basis for the rationale to combine *Stevelim* and *Lovelace* other than the Examiner's subjective opinion, which is not objective evidence. The factual question of motivation to combine references is material to patentability. *In re Lee*, 61 USPQ2d 1430, 1434 (CA FC 2002) The question is whether the prior art, considering its scope and content and the level of ordinary skill, must itself suggest the combination of separate elements into the claimed invention in suit, not just whether it illustrates separate elements. *The Laitram Corporation et al. v. Cambridge Wire Cloth Company*, 226 USPQ 289, 293 (DC Md 1985). Since the Examiner is unable to point to any specific teaching or suggestion in the prior art of the advantage to combine *Stevelim* and *Lovelace*, other than illustrating certain separate elements that appear in the prior art, Applicants respectfully conclude that the Examiner has rejected claims 8 and 28 based on hindsight, using knowledge of the claimed invention to construct a case for obviousness in rejecting the invention. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, to use the inventor's teaching against him. *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (CA FC 1983). In

summary, Applicants respectfully assert that the Examiner withdraw the rejection of claims 8 and 28 and allow these claims for issue.

B.5 *Stevelim* and *Lovelace*, taken singly or in combination, do not teach or suggest the limitations in claims 9 and 29; no appropriate motivation to combine the references

The Examiner admits *Stevelim* and *Lovelace* do not teach the steps in claims 9 and 29 for "moving the contents of said third entry to said second entry", marking the second partition as active in the MBR, and booting from the newly activated, primary (formerly second) partition. See Office Action 04/05/2005, p.8. The Examiner's stated rationale is that because *Stevelim* discloses boot managers that handle one OS, handling just two OS's is obvious. For at least the reasons stated in sections B.3 and B.4 of this paper, Applicants respectfully traverse the rejection of claims 9 and 29. Neither *Stevelim* nor *Lovelace* disclose a boot manager that migrates or increments the active partition entry. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9 and 29, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (CA FC 1998). In summary, Applicants respectfully assert that the Examiner withdraw the rejection of claims 9 and 29 and allow these claims for issue.

B.6 Regarding claim 31, the Examiner has not provided appropriate motivation to combine *Stevelim* with *Lovelace*.

The Examiner admits that *Stevelim* does not teach several limitations of claim 31, including maintaining a version management table in non-volatile memory, comparing data in the version management table to the active MBR and booting if the result for a match is true. See Office Action 04/05/2005, pp. 9-10. The Examiner does not provide any objective evidence for the existence of a version management table in the boot manager disclosed by *Stevelim*, except his own subjective opinion. Despite this, the Examiner assumes that the version management table "must exist in the boot managers disclosed by *Stevelim* or there would be no way for the boot managers to keep track of which BP is the active version and which should be designated as alternates." See Office Action 04/05/2005, pp. 9-10. Applicants respectfully traverse and assert that *Stevelim* does not disclose a boot manager that maintains a version management table and designates alternates to the active version. The Examiner has not presented a *prima facie* case of obviousness in rejecting claim 31, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d



1453, 1455 (CA FC 1998). The Examiner cannot support a *prima facie* case of obviousness with an "assumption."

The Examiner's cited motivation for one of ordinary skill in the art to combine *Stevelim* with *Lovelace* is to "allow for the boot managers disclosed by *Stevelim* to verify the integrity of the boot components of the BP before booting" in order to prevent "possible infection by viruses" See Office Action 04/05/2005, p.10. Applicants respectfully traverse. *Stevelim* does not address verification of integrity of boot components and does not discuss protection of bootable partitions from infection by a virus or any other kind of malignant software code.

Using the test (a) as cited above (*In re Sernaker*), the combination of *Stevelim* and *Lovelace* does not suggest, expressly or by reasonable implication, an improvement along the lines of the invention, as embodied in claim 31. Applying test (b) as cited above (*In re Sernaker*), the invention, as embodied in claim 31, clearly achieves more than *Stevelim* in view of *Lovelace* suggests, expressly or by implication. Applicants respectfully assert that there is nothing in the prior art which suggests the desirability, ergo the obviousness, of combining *Stevelim* with *Lovelace*. The Examiner has provided no objective basis for the rationale to combine *Stevelim* and *Lovelace* other than the Examiner's subjective opinion, which is not objective evidence. The factual question of motivation to combine references is material to patentability. *In re Lee*, 61 USPQ2d 1430, 1434 (CA FC 2002). The question is whether the prior art, considering its scope and content and the level of ordinary skill, must itself suggest the combination of separate elements into the claimed invention in suit, not just whether it illustrates separate elements. *The Laitram Corporation et al. v. Cambridge Wire Cloth Company*, 226 USPQ 289, 293 (DC Md 1985). Since the Examiner is unable to point to any specific teaching or suggestion in the prior art of the advantage to combine *Stevelim* and *Lovelace*, other than illustrating certain separate elements that appear in the prior art, Applicants respectfully conclude that the Examiner has rejected claim 31 based on hindsight, using knowledge of the claimed invention to construct a case for obviousness in rejecting the invention. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, to use the inventor's teaching against him. *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (CA FC 1983). In summary, Applicants respectfully assert that the Examiner withdraw the rejection of claim 31 and allow these claims for issue.

B.7 Regarding claim 34, The Examiner has not provided any objective evidence or appropriate motivation to combine *Stevelim* with *Lovelace* and used hindsight to construe obviousness.

The Examiner admits that *Stevelim* does not teach several limitations of claim 34, including replacing the data in the active entry with the data in the alternate entry if the first result in claim 31 is false, comparing the former alternate data now in the active entry to the active MBR and booting with the alternate version if the result for a match is true. *See* Office Action 04/05/2005, pp. 11. The Examiner asserts that the additional limitations in claim 34 would have been obvious to one of ordinary skill in the art "if said first result is false as this would mean that the boot components of the first BP is [sic] corrupted." The Examiner has provided no objective evidence or reference for this interpretation of said first result, except his own subjective opinion. *Lovelace* does not teach a method with an alternate entry or replacing the primary entry with an alternate entry. The Examiner has not presented a *prima facie* case of obviousness in rejecting claim 34, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (CA FC 1998).

An Examiner cannot establish obviousness by combining the teachings of the prior art without providing evidence of the motivating force which would impel one skilled in the art to do what the patent Applicants have done. For at least the reasons cited in section B.1. of this paper, the Examiner has not provided sufficient incentive or suggestion of the desirability, ergo the obviousness, in combining *Stevelim* with *Lovelace* to obtain an improvement along the lines of the invention. Absent such reasons or incentives, the teachings of the references are not combinable. *Ex parte Skinner*, 2 USPQ 2d 1788, 1790 (B.P.A.I. 1986).

A rejection based on §103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). The proper inquiry is whether bringing them together was obvious and not, whether one of ordinary skill, having the invention before him, would find it obvious through hindsight to construct the invention. The Examiner cites motivation for one of ordinary skill in the art to modify the combination of *Stevelim* with *Lovelace*, to further incorporate the exact limitations found in claim 34 in order "find a way to repair the corrupted boot components." *See* Office Action

04/05/2005, p.12. *Stevelim* does not teach the repair of bootable partitions after infection by a virus or any other kind of malignant software code. *Lovelace* does not teach a version management table or a second entry, replacing said active entry with the data in said second entry, or booting with an alternate version after a second compare operation.

In summary, Applicants respectfully assert that the Examiner withdraw the rejection of claim 34 and allow these claims for issue.

B.8 *Stevelim* and *Lovelace*, taken singly or in combination, do not teach or suggest the limitations in claim 35; no appropriate motivation to combine the references

The Examiner admits *Stevelim* and *Lovelace* do not teach the steps in claim 35 for "stopping booting of said computer system if said second compare result is false." See Office Action 04/05/2005, p.12. The Examiner's stated rationale for declaring claim 35 obvious is that because both compare results are now false, the boot components of both boot partitions are corrupted. Applicants respectfully traverse. The Examiner has provided no objective evidence or reference for this interpretation of this compare result, except his own subjective opinion. Furthermore, neither *Stevelim* nor *Lovelace* disclose a second compare operation. Therefore the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 35, since the Examiner is relying upon his own unsupported statement in support of the rejection. Therefore Applicants respectfully assert that the Examiner withdraw the rejection of claim 35 and allow this claim for issue.

An Examiner cannot establish obviousness by combining the teachings of the prior art without providing evidence of the motivating force which would impel one skilled in the art to do what the patent Applicants have done. For at least the reasons cited in section B.1. of this paper, the Examiner has not provided sufficient incentive or suggestion of the desirability, ergo the obviousness, in combining *Stevelim* with *Lovelace* to obtain an improvement along the lines of the invention. Absent such reasons or incentives, the teachings of the references are not combinable. *Ex parte Skinner*, 2 USPQ 2d 1788, 1790 (B.P.A.I. 1986).

In summary, Applicants respectfully assert that the Examiner withdraw the rejection of claim 35 and allow these claims for issue.

B.9 *Stevelim* does not teach or suggest the step in claim 36

The Examiner cites *Stevelim* (p1, bullet 1) as disclosing the limitation in claim 36. Applicants respectfully traverse. *Stevelim* does not teach version management by the boot manager or changing the active partition entry in response to a version management command sequence. *Stevelim* discloses a boot manager that allows the user to manually select the boot program and boot partition using LILO in a preconfigured scenario. *Stevelim* teaches that the configuration or any change thereof in the designated boot partitions and boot programs is an offline function that must be performed separately before LILO is used. Therefore the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 36, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (CA FC 1998). In summary, Applicants respectfully assert that the Examiner withdraw the rejection of claim 36 and allow these claims for issue.

B.10 Reasoning for accepting claim 7 applies to claim 39

Applicants acknowledge the Examiner's statement that the limitations recited by claim 7 and claim 39 are substantially similar. Claim 39 is therefore allowable for at least the reasons and arguments presented in section B.3 of this paper in support of claim 7. Applicants respectfully assert that the Examiner withdraw the rejection of claim 39 and allow this claim for issue.

B.11 Reasoning for accepting claim 8 applies to claim 40

Applicants acknowledge the Examiner's statement that the limitations recited by claim 8 and claim 40 are substantially similar. Claim 40 is therefore allowable for at least the reasons and arguments presented in section B.4 of this paper in support of claim 8. Applicants respectfully assert that the Examiner withdraw the rejection of claim 40 and allow this claim for issue.

B.12 Reasoning for accepting claim 9 applies to claim 41

Applicants acknowledge the Examiner's statement that the limitations recited by claim 9 and claim 41 are substantially similar. Claim 41 is therefore allowable for at least the reasons and arguments presented in section B.5 of this paper in support of claim 9. Applicants

respectfully assert that the Examiner withdraw the rejection of claim 41 and allow this claim for issue.

Claims 2, 10, 22, 30, 32-33, and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Stevelim* (as referred to in the Examiner's Office Action) in view of *Lovelace* et al. (U.S. Patent 6,263,431) and further in view of Applicants' admittance of prior art. Applicants respectfully traverse these rejections for at least the reasons below and respectfully request the Examiner to reconsider and withdraw these rejections.

B.13 Reasoning for accepting claim 1 applies to claim 11

Applicants acknowledge the Examiner's statement that the limitations recited by claim 1 and claim 11 are substantially similar, except that claim 11 refers to CPU circuitry which performs the methods of claim 1. Claim 11 is therefore allowable for at least the reasons and arguments presented in section B.1 of this paper in support of claim 1. Applicants respectfully assert that the Examiner withdraw the rejection of claim 11 and allow this claim for issue.

B.14 Dependent claim 13

Claim 13 depends from claim 11 with the additional limitation of a boot program that is an operating system. Claim 13 is therefore allowable for at least the reasons cited in section B.1 of this paper. Applicants respectfully assert that the rejection of claim 13 be withdrawn.

B.15 Reasoning for accepting claims 7, 8 and 9 applies to claims 17, 18, and 19

Applicants acknowledge the Examiner's statement that the limitations recited by claims 7, 8, and 9 and claims 17, 18, and 19, respectively, are substantially similar, except that claims 17, 18, and 19 refer to circuitry which performs the methods of claims 7, 8, and 9, respectively. Claims 17, 18, and 19 are therefore allowable for at least the reasons and arguments presented in sections B.3, B.4, and B.5 of this paper in support of claims 7, 8, and 9, respectively. Applicants respectfully assert that the Examiner withdraw the rejection of claims 17, 18, and 19 and allow these claims for issue.

B.16 Reasoning for accepting claim 31 applies to claim 43

Applicants acknowledge the Examiner's statement that the limitations recited by claim 31 and claim 43 are substantially similar, except that claim 43 refers to CPU circuitry which performs the methods of claim 31. Claim 43 is therefore allowable for at least the reasons and arguments presented in section B.6 of this paper in support of claim 31. Applicants respectfully assert that the Examiner withdraw the rejection of claim 43 and allow this claim for issue.

B.17 Reasoning for accepting claims 34, 35, 36, 39, 40, and 41 applies to claims 46, 47, 48, 51, 52, and 53

Applicants acknowledge the Examiner's statement that the limitations recited by claims 34, 35, 36, 39, 40 and 41 and claims 46, 47, 48, 51, 52, and 53, respectively, are substantially similar, except that claims 46, 47, 48, 51, 52, and 53 refer to circuitry which performs the methods of claims 34, 35, 36, 39, 40 and 41, respectively. Claims 46, 47, 48, 51, 52, and 53 are therefore allowable for at least the reasons and arguments presented in sections B.7, B.8, B.9, B.10, B.11 and B.12 of this paper in support of claims 34, 35, 36, 39, 40 and 41, respectively. Applicants respectfully assert that the Examiner withdraw the rejection of claims 46, 47, 48, 51, 52, and 53 and allow these claims for issue.

B.18 Dependent claims 2 and 22

Claims 2 and 22 depend from claims 1 and 21 with the additional limitation of locking said first and second entries in said non-volatile memory with a hardware locking mechanism. The Examiner states that "it would have been obvious to one of ordinary skill in the art to further modify *Stevelim* and *Lovelace's* combination method and system." See Office Action 04/05/2005, p.20. Applicants respectfully traverse. The Examiner has not provided any objective evidence which teaches the incentive or motivation to combine *Stevelim* with *Lovelace*, except his own subjective opinion. The Examiner's case of obviousness, based on a further modification of the combination to generate the exact limitations in claims 2 and 22, is *de facto* hindsight in view of the present invention. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Claims 2 and 22 are therefore allowable for at least the reasons cited in sections B.1 and B.6 of this paper. Applicants respectfully assert that the rejection of claims 2 and 22 be withdrawn.

B.19 Reasoning for accepting claims 2 and 22 applies to claims 10 and 30

Applicants acknowledge the Examiner's statement that the limitations recited by claims 2 and 22 and claims 10 and 30, respectively, are substantially similar. Claims 10 and 30 are therefore allowable for at least the reasons and arguments presented in section B.18 of this paper in support of claims 2 and 22, respectively. Applicants respectfully assert that the Examiner withdraw the rejection of claims 10 and 30 and allow these claims for issue.

#### B.20 Dependent claim 32

Claim 32 depends from claim 31 with the additional limitation of locking said active and alternate entries in said version management table are locked with a hardware locking mechanism. The Examiner states that "it would have been obvious to one of ordinary skill in the art to further modify *Stevelim* and *Lovelace*'s combination method." See Office Action 04/05/2005, p.21. Applicants respectfully traverse. The Examiner has not provided any objective evidence which teaches the incentive or motivation to combine *Stevelim* with *Lovelace*, except his own subjective opinion. The Examiner's case of obviousness, based on a further modification of the combination to generate the exact limitations in claim 32, is *de facto* hindsight in view of the present invention. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Claim 32 is therefore allowable for at least the reasons cited in sections B.1 and B.6 of this paper. Applicants respectfully assert that the rejection of claim 32 be withdrawn.

#### B.21 Dependent claim 33

Claim 33 depends from claim 31 with the additional limitation of a boot program that is an operating system. Claim 33 is therefore allowable for at least the reasons cited in section B.6 of this paper in support of claim 31. Applicants respectfully assert that the rejection of claim 33 be withdrawn.

#### B.22 Dependent claim 42

Claim 42 depends from claim 41 with the additional limitation of locking said active and alternate entries in said version management table are locked with a hardware locking mechanism. The Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the Applicants' invention was made to further modify the combination method of

*Stevelim* and *Lovelace*." See Office Action 04/05/2005, p22. Applicants respectfully traverse. The Examiner has not provided any objective evidence which teaches the incentive or motivation to combine *Stevelim* with *Lovelace*, except his own subjective opinion. The Examiner's case of obviousness, based on a further modification of the combination to generate the exact limitations in claim 42, is *de facto* hindsight in view of the present invention. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Claim 42 is therefore allowable for at least the reasons cited in sections B.1 and B.6 of this paper. Applicants respectfully assert that the rejection of claim 42 be withdrawn.

Claims 12, 20, 44-45, and 54 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Stevelim* (as referred to in the Examiner's Office Action) in view of *Lovelace* et al. (U.S. Patent 6,263,431) and *Rickey* et al. (U.S. 2002/0166059) and further in view of Applicants admittance of prior art. Applicants respectfully traverse these rejections for at least the reasons below and respectfully request the Examiner to reconsider and withdraw these rejections.

#### B.23 Dependent claim 12

Claim 12 depends from claim 10 with the additional limitation of locking said first and second entries in said non-volatile memory with a hardware locking mechanism. The Examiner states that "it would have been obvious for one of ordinary skill in the art to further modify *Stevelim*, *Lovelace* and *Rickey*'s combination computer system." See Office Action 04/05/2005, p23. Applicants respectfully traverse. The Examiner has not provided any objective evidence which teaches the incentive or motivation to combine *Stevelim* with *Lovelace*, except his own subjective opinion. The Examiner's case of obviousness, based on a further modification of the combination to generate the exact limitations in claim 12, is *de facto* hindsight in view of the present invention. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Claim 12 is therefore allowable for at least the reasons cited in section B.1 and B.6 of this paper. Applicants respectfully assert that the rejection of claim 12 be withdrawn.

#### B.24 Reasoning for accepting claims 12 and 32 applies to claims 20 and 44



Applicants acknowledge the Examiner's statement that the limitations recited by claims 12 and 32 and claims 20 and 44, respectively, are substantially similar. Claims 20 and 44 are therefore allowable for at least the reasons and arguments presented in section B.23 and B.20 of this paper in support of claims 12 and 32, respectively. Applicants respectfully assert that the Examiner withdraw the rejection of claims 20 and 44 and allow these claims for issue.

B.25 Dependent claim 45

Claim 45 depends from claim 43 with the additional limitation of a boot program that is an operating system. Claim 45 is therefore allowable for at least the reasons cited in section B.16 of this paper in support of claim 43. Applicants respectfully assert that the rejection of claim 45 be withdrawn.

B.26 Dependent claim 54

Claim 54 depends from claim 53 with the additional limitation of locking said active and alternate entries in said non-volatile memory. The Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the Applicants invention was made to further modify the combination method of *Stevelim*, *Lovelace*, and *Rickey*." See Office Action 04/05/2005, p24. Applicants respectfully traverse. The Examiner has not provided any objective evidence which teaches the incentive or motivation to combine *Stevelim* with *Lovelace*, except his own subjective opinion. The Examiner's case of obviousness, based on a further modification of the combination to generate the exact limitations in claim 54, is *de facto* hindsight in view of the present invention. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Claim 54 is therefore allowable for at least the reasons cited in section B.1 and B.6 of this paper. Applicants respectfully assert that the rejection of claim 54 be withdrawn.

Claims 4-6, 24-26, and 37-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Stevelim* (as referred to in the Examiner's Office Action) in view of *Lovelace* et al. (U.S. Patent 6,263,431) and further in view of *Schieve* et al. (U.S. Patent 5,463,766). Applicants respectfully traverse these rejections for at least the reasons below and respectfully request the Examiner to reconsider and withdraw these rejections.

#### B.27 Dependent claims 4 and 24

Claims 4 and 24 depend from claims 1 and 21, respectively, with the additional limitation of loading a BR from the active partition entry of the MBR using POST code on power up, decrypting the first signature using a public installation key, comparing the hash of the BR of the active partition to a hash of a BR from the active entry, booting with the first version of the boot program if the compare is true, retrieving the second signature from the alternate entry when the compare is false. The Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the Applicants invention was made in light of *Lovelace* and *Schieve*'s teaching to further modify the combination method of *Stevelim* and *Lovelace*." See Office Action 04/05/2005, pp.24, 27. Applicants respectfully traverse. The Examiner has not provided any objective evidence which teaches the incentive or motivation to combine *Stevelim* with *Lovelace*, except his own subjective opinion. The Examiner's case of obviousness, based on a further modification of the combination to generate the exact limitations in claims 4 and 24, is *de facto* hindsight in view of the present invention. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Claims 4 and 24 are therefore allowable for at least the reasons cited in section B.1 and B.6 of this paper. Applicants respectfully assert that the rejection of claims 4 and 24 be withdrawn.

#### B.28 Dependent claims 5 and 25

Claims 5 and 25 depend from claims 4 and 24 respectively, with the additional limitations of decrypting the second signature in the alternate entry using a public installation key, comparing the hash of the active partition BR to the hash from the alternate entry, clearing the active entry if true, and moving the contents from the alternate entry to the active entry and booting with the alternate version defined by the active entry. The Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the Applicants invention was

made to further modify *Stevelim*, *Lovelace*, and *Schieve*'s combination invention." *See* Office Action 04/05/2005, p.29. Applicants respectfully traverse. The Examiner has not provided any objective evidence which teaches the incentive or motivation to combine *Stevelim* with *Lovelace*, except his own subjective opinion. The Examiner's case of obviousness, based on a further modification of the combination to generate the exact limitations in claims 5 and 25, is *de facto* hindsight in view of the present invention. The patentability of an invention is not to be viewed with hindsight or "viewed after the event." *Goodyear Company v. Ray-O-Vac Company*, 321 U.S. 275, 279, 64 S.Ct. 593, 88 L.Ed. 721 (1944). Claims 5 and 25 are therefore allowable for at least the reasons cited in section B.1 and B.6 of this paper. Applicants respectfully assert that the rejection of claims 5 and 25 be withdrawn.

#### B.29 Dependent claims 6 and 26

Claims 5 and 25 depend from claims 4 and 24 respectively, with the additional limitation of "halting said POST when said second compare result is false". The Examiner states that "it would have been obvious to one of ordinary skill in the art in light of *Schieve*'s teachings to halt POST when the second compare result is false." *See* Office Action 04/05/2005, p.29. Applicants respectfully traverse. *Schieve* does not teach halting POST for any reason or any of the antecedent methods of claims 6 and 26 involving a first and second compare result. Applicants respectfully assert that the Examiner has not provided any objective evidence of obviousness in light of *Schieve*, except his own subjective opinion. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 6 and 26, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (CA FC 1998). Applicants respectfully assert that the rejection of claims 6 and 26 be withdrawn and that these claims be allowed for issue.

#### B.30 Dependent claims 37 and 38

Claims 37 and 38 depend from claims 31 and 34 respectively, with the additional limitation "where said compare step is performed by Power-On Self-Test (POST) code". The Examiner states that "it would have been obvious to one of ordinary skill in the art to have the compare step be performed by POST in light of *Schieve*'s teachings." *See* Office Action 04/05/2005, p.30. Applicants respectfully traverse. *Schieve* does not teach using POST for a compare operation from primary or alternate entries. Neither does *Schieve* teach any of the

antecedent methods of claims 37 and 38. Applicants respectfully assert that the Examiner has not provided any objective evidence of obviousness in light of *Schieve*, except his own subjective opinion. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 37 and 38, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (CA FC 1998). Applicants respectfully assert that the rejection of claims 37 and 38 be withdrawn and that these claims be allowed for issue.

Claims 14-16 and 49-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Stevelim* (as referred to in the Examiner's Office Action) in view of *Lovelace et al.* (U.S. Patent 6,263,431) and *Rickey et al.* (U.S. 2002/0166059) further in view of *Schieve et al.* (U.S. Patent 5,463,766). Applicants respectfully traverse these rejections for at least the reasons below and respectfully request the Examiner to reconsider and withdraw these rejections.

B.31 Reasoning for accepting claims 4, 5 and 6 applies to claims 14,15, and 16

Applicants acknowledge the Examiner's statement that the limitations recited by claims 4, 5 and 6 and claims 14, 15 and 16, respectively, are substantially similar, except that claims 14, 15 and 16 refer to a computer system comprising circuitry which performs the methods of claims 4, 5 and 6, respectively. Claims 14, 15 and 16 are therefore allowable for at least the reasons and arguments presented in sections B.27, B.28, and B.29 of this paper in support of claims 4, 5 and 6, respectively. Applicants respectfully assert that the Examiner withdraw the rejection of claims 14, 15 and 16 and allow these claims for issue.

B.32 Reasoning for accepting claims 37 and 38 applies to claims 49 and 50

Applicants acknowledge the Examiner's statement that the limitations recited by claims 37 and 37 and claims 49 and 50, respectively, are substantially similar, except that claims 49 and 50 refer to computer system which implements the methods of claims 37 and 38. Claims 49 and 50 are therefore allowable for at least the reasons and arguments presented in section B.30 of this paper in support of claims 37 and 38, respectively. Applicants respectfully assert that the Examiner withdraw the rejection of claims 49 and 50 and allow these claims for issue.

## IV. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that claims 1-54 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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